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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,196	03/18/2004	Yoshiyuki Baba	81756.0007	5112
26021 7590 10/31/2007 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 6 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claim 6, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium storing an option computer program..." in order to make the claim statutory.

Claim Objections

2. Claims are objected to because of the following informalities:

Claims 1, 5 and 6, "(below, referred to as "the connected printer")" should be deleted since the claim wording is evidently clear that the printer is "the connected printer".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to claim 1, it recites the limitations for inquiring "a print function usable with the connected printer" and realizing "a specific function". It is unclear as to how those two functions are different. According to page 6, lines 19-26 of the Specification, the difference is not clear. For example, if the inquired color print function is designated and operated to realize the specific function, what function should be construed as the "specific function"? How is the step of inquiring different from the step of realizing? Explanation/clarification from the Specification is respectfully requested.

4. Furthermore, it recites the limitation "a print function usable with the connected printer". It is unclear if there ever is a situation where the print function is not usable with the connected printer. With respect to what, is the print function determined to be usable or not usable? Or is it simply claiming the printer capability regardless the presence/absence of the option module? Explanation/clarification from the Specification is respectfully requested.

5. With respect to claims 5 and 6, arguments analogous to those presented for claim 1, are applicable.

6. Claim 7 recites the limitation "a printer". There is insufficient antecedent basis for this limitation in the claim. It is unclear if it is referring to the same printer recited in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Breidenbach et al. U.S. Patent Application Publication No. 2003/0084085 (hereinafter Breidenbach).

7. With respect to claim 1, Breidenbach discloses an option module (peripheral device software 210 in fig. 2 or auto recognition logic 410, 420, 430 in fig. 4) for realizing a specific function (printing the data in specific function supported by the printer capabilities) while being connected to a printer (fig. 3), comprising:

means for inquiring to the printer to which the option module is connected regarding a print function (step 312 or paragraphs 49~53) usable with the connected printer (fig. 5 & paragraphs 40~42 & 53~55),

wherein only the print function usable with the connected printer is designated and operated to realize the specific function (paragraphs 40~42 & 53~55).

8. With respect to claim 2, Breidenbach discloses the option module according to claim 1, wherein the specific function (printing the data in specific function supported by the printer capabilities) is a function for generating a print image based on data described in a printer control language. Note that generating the print image data based on data described in a printer control language is inherent since the printer must be able to understand the control command to perform the printing task.

9. With respect to claim 3, Breidenbach discloses the option module according to claim 1, wherein the print function includes at least one of: a function to print at a specific resolution level, a double-sided print function, a print function using a secondary memory device, a print function using a specific paper feeder or paper discharge tray, a

print function using a mailbox, a collate print function, and a color print function (paragraphs 52~55).

10. With respect to claim 4, Breidenback discloses the option module according to claim 1, wherein the option module is a memory device storing a program, and the program is executed on the printer to realize the specific function (paragraph 31).

11. With respect to claims 5 and 6, arguments analogous to those presented for claim 1, are applicable.

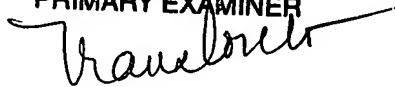
12. With respect to claim 7, Breidenback discloses a printing system, comprising: the option module according to claim 1; and a printer constructed so as to be able to connect with the option module (fig. 4).

Contact Information


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PRIMARY EXAMINER


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csp
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